

REMARKS

Claims 9-14 have been cancelled without prejudice to the filing of continuing applications. Claims 1-8 are now pending in this application.

Rejection Under 35 U.S.C. § 112, First Paragraph

The Office has maintained the § 112 rejection of claims 9-14 which was asserted in the Office Action mailed August 29, 2002. While Applicants' do not agree with this rejection, the rejection is obviated by the cancellation of claims 9-14. Withdrawal of the rejection is therefore respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

The Office has maintained the § 103 rejections asserted in the Office Action mailed August 29, 2002. Under these rejections, claims 1-8 stand rejected as being unpatentable over WO 96/11676 ("Ducharme") in view of U.S. Patent Number 5,760,068 ("Talley") and also as being unpatentable over U.S. Patent Number 6,136,839 ("Isakson").

In Applicants' Response to the August 29, 2002 Office Action, Applicants argued that under 35 U.S.C. § 103(c), the cited references are not prior art. In the present Office Action, the Office contends that Applicants' 103(c) arguments are moot because Applicants have not properly established the priority of the instant application.

Enclosed with this Response is a newly executed Declaration, which properly specifies the parent applications of the instant application and thus properly establishes the priority of the instant application.

The enclosed Declaration, together with Applicants' arguments in the Response to the August 29, 2002 Office Action, which arguments are herein incorporated by reference, overcome the § 103 rejections. In summary, those arguments are as

follows. The instant application qualifies under 35 U.S.C. § 103(c) because the application was filed after November 29, 1999. Further, the Talley and Isakson references were published after Applicants' earliest priority date and therefore can only be considered prior art under § 102(e)/103. Because the instant Application and the Talley and Isakson references were, at the time the invention was made, subject to an obligation of assignment to the same person, the references are disqualified under § 103(c) from being prior art. Finally, Ducharme alone cannot support a § 103 rejection because Ducharme does not disclose or suggest Applicants' pyrazolyl derivatives or the use of these compounds as COX-II inhibitors.

For the above reasons, Applicants respectfully request withdrawal of the 35 U.S.C. § 103 rejections of claims 1-8

Reconsideration and withdrawal of the rejections are respectfully requested. Should the Examiner believe that a discussion of this matter would be helpful, he is invited to telephone the undersigned at (312) 913-0001.

Respectfully submitted,

Dated: March 6, 2003

By:

Raafat M. Shaltout

Raafat M. Shaltout

Reg. No. 45,092

McDONNELL BOEHNEN
HULBERT & BERGHOFF
300 South Wacker Drive
Chicago, Illinois 60606
(312) 913-0001